

REMARKS

This Amendment responds to the Office Action dated December 7, 2004.

The Examiner rejected claims 1-40 and 47-59 under 35 U.S.C. § 101, arguing that the claimed “JPEG2000 file” was non-statutory subject matter. The Examiner incorrectly believes that a “file” is a “data structure” or “abstract idea.” This contention is erroneous. A “file,” though recorded digitally on some arbitrary medium such as a hard drive or compact disk, is not merely a data structure. Digital files, such as the claimed files, are commonly transferred, purchased, sold, and copied. As a point of law, digital files are copyrightable subject matter, which is not true of a mathematical formula or an abstract idea. The Examiner’s restriction of claims 1-40 and 47-59 is therefore without basis.

The Examiner similarly rejected claims 41-46 which were directed to a “description scheme.” Each of these claims has been amended to claim a “digital file” which, as stated previously, is statutory subject matter. The Examiner’s rejection of these claims under 35 U.S.C. § 101 should therefore be withdrawn.

The Examiner rejected claims 1-59 for claiming “a JPEG2000 file comprising said JPEG2000 file.” These claims have been amended to claim a “digital file” ... arranged in a manner consistent with the JPEG 2000 specification. These amendments overcome the Examiner’s objection.

The Examiner objected to claim 53 because the term “said content” lacked antecedent basis. Claim 53 has been amended to replace this term with “said image” which has antecedent basis.

The Examiner objected to claims 29-40 because independent claim 29 misspelled MPEG. This misspelling has been corrected.

The Examiner rejected claims 41-42 and 46 under 35 U.S.C. § 102(b) as being anticipated by Pereira. The Examiner contends that this reference discloses the claimed limitation of an MPEG-7 description scheme ... including data for rendering said at least one of said audio and visual media.” The Examiner is incorrect as Pereira expressly states that the disclosed MPEG-7 scheme does not include such data, and that, instead MPEG 4.2.2 content, which is sometimes co-located with an MPEG-7 description scheme, contains this data. Thus, Pereira’s MPEG-7 description scheme *does not* include “data for rendering said at least one of said audio and visual media.” The Examiner’s rejection of claims 41-42 and 46 should therefore be withdrawn.

The Examiner rejected claims 47-49 and 54 under 35 U.S.C. § 102(a) as being anticipated by the IT-JPEG2000 reference. Independent claim 47 includes the limitation of “a plurality of boxes containing data. . . suitable to render an image” where at least one of the boxes is “at least one of a metadata box and a UUID box.” Claim 47 includes the further limitation that the “at least one of said metadata box and said UUID box” include information indicating the location of binary data that is within the file but not in the “at least one of said metadata box and said UUID box.”

Contrary to the Examiner’s rejection, the IT-JPEG2000 reference does not disclose these limitations. That reference discloses a JP2 file format that includes UUID boxes that may include binary data containing vendor-specific information about the JP2 file unnecessary to decode the image. The UUID box disclosed by the IT-JPEG2000 reference contains no information as to the

location of data outside the UUID box. The IT-JPEG2000 reference also discloses UUID Info boxes that lists one or more of the UUID boxes included within the file and optionally includes a link to a URL containing additional information about the file. The UUID Info box, however is by definition not a UUID box, since it lists UUID boxes in the file and since the format of a UUID Info box does not conform to the format of a UUID box (compare IT-JPEG2000 at I.9.2 describing the format of UUID boxes with IT-JPEG2000 at I.9.3 describing the format of UUID List boxes.) Thus, to the extent that the UUID List box may contain references to data outside of the UUID List box, independent claim 47, along with its dependent claims 48, 49, and 54 still patentably distinguishes over the IT-JPEG2000 reference because the UUID List box is not “at least one of a metadata box or a UUID box.” The Examiner’s rejection of these claims should therefore be withdrawn.

The Examiner rejected the remaining claims under 35 U.S.C. § 103(a) in view of the combination of Pereira and Qian et al., U.S. Patent No. 6,070,167. Attached to this response is a declaration that removes Qian from consideration under 35 U.S.C. § 103. Because Richard Qian is a common inventor to both the cited reference and the present application, Qian is not prior art under 35 U.S.C. § 102(a). Because the present application claims priority to a date less than one year after the issuance of Qian, that reference is unavailable as prior art under 35 U.S.C. § 102(b). 35 U.S.C. §§ 102(c) and (d) are inapplicable. Therefore, Qian is only prior art under 35 U.S.C. § 102(e). Because the present application and Qian were commonly assigned at the time the present application was filed, Qian is not available as prior art in an obviousness rejection. Therefore, the Examiner’s rejection of claims 1-40, 50-53 and 55-59 should be withdrawn.

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Amdt. dated June 7, 2005
Reply to Office Action of December 7, 2004

In view of the foregoing amendments and remarks, the applicant respectfully requests reconsideration and allowance of claims 1-59.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Kurt", followed by a long horizontal line that extends to the right.

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